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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/264,432	03/08/1999	PHILLIP Y. GOLDMAN	14531.46	3073

22913 7590 12/18/2002

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EXAMINER

BELIVEAU, SCOTT E

ART UNIT PAPER NUMBER

2614

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/264,432

Applicant(s)

GOLDMAN ET AL.

Examiner

Scott Beliveau

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 27 November 2002 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on 27 November 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/264432 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Drawings***

2. The applicant's amendments to the specifications and remarks pertaining to the drawing legend have been noted. The objection to the drawings are hereby withdrawn, save the objection to Figure 4 noted in the previous Office Action in which it was indicated that element "110" should refer to element "410". While the applicant addresses this correction in their remarks, the proposed drawing correction filed on 27 November 2002 has been disapproved because it is not in the form of a pen-and-ink sketch showing changes in red ink or with the changes otherwise highlighted. See MPEP § 608.02(v).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as Perlman et al. (WO 98/56128) at the time this invention was made. Accordingly, Perlman et al. (WO 98/56128) is disqualified as prior art through 35 U.S.C. 102(e), (f) or (g) in any rejection under 35 U.S.C. 103(a) in this application. However, this applied art additionally qualifies as prior art under another subsection of 35 U.S.C. 102 and accordingly is not disqualified as prior art under 35 U.S.C. 103(a).

Applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the inventor of this application, and is therefore, not the invention "by another", or by antedating the applied art under 37 CFR 1.131.

6. Claims 1-9, 12, 20-26, and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. (WO 98/56128), in view of Belmont (US Pat No. 5,819,156), and in further in view of Robinson (US Pat No. 5,918,014).

In reference to claim 1, the Perlman et al. (WO 98/56128) reference shows the schematic structure of a communications network for use with an "information retrieval system" such as the WebTV® client terminal [180] (Figure 1B). The client terminal [180] facilitates shared

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screen viewing of television/internet content. Subsequently, it handles both the “request” for and “display” of “information documents” or HTML web pages (Page 5, Lines 9-19). The Perlman et al. reference teaches that the embodiment is operable to “compile a profile of the user of the information system” using a variety of means so as to deliver material including advertisements to the user during off-peak hours (Page 12, Lines 5-21). Advertisements are subsequently inserted into the retrieved “information documents” based on based on the “profile” (Page 13, Lines 22-28).

The aforementioned Perlman et al. (WO 98/56128) reference suggests the use of other techniques for developing profiles of user interest in conjunction with the aforementioned embodiment. These techniques include the tracking of viewership information that is subsequently sent to the server (Page 12, Lines 16-18). The reference, however, does not explicitly disclose the use of tracking “information associated with the television programming viewed by the user” unless one broadly interprets the tracking of viewed/browsed web sites on the WebTV® television set as a form of “television programming”. The Belmont reference discloses a PC/TV [10] that is operable to generate, store [32] (Col 4, Lines 28-35), and compile viewer behavior for any application and usage of a PC/TV convergence device (Col 3, Lines 24-52; Col 4, Lines 23-28). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the tracking/reporting teachings of Belmont to determine “information associated with the television programming viewed by the user” in conjunction with the Perlman et al. usage tracking for the purposes of providing a means by which television programmers and software

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vendors may obtain usage information so as to develop more detailed user/viewer profiles (Belmont: Col 1, Lines 42-60).

As to the aforementioned advertisement selection process, the Perlman et al. reference suggests that the process may be conducted automatically, but does not provide explicit details as to how this might be accomplished (Page 12, Lines 5-13; Page 13, Lines 24-22-28). One such known method involves automated collaborative filtering (ACF). The Robinson reference teaches a method whereby automated collaborative filtering (ACF) techniques may be used to “select” targeted advertisements to present to users based on their “community” or profile (Col 4, Lines 8-38). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the Robinson teachings of “advertisement selection” with the advertisement selection process of Perlman et al. for the purposes of providing a technique for selecting appropriate advertisements users based on their interests (Perlman et al.: Page 13, Lines 26-28). The “selected” ads are subsequently inserted into the “information document” as appropriate (Robinson: Col 4, Lines 44-50). The Robinson reference teaches that user profiles may be constructed “to further characterize the user” using a combination of user supplied demographic data, and tracking or “monitoring” information obtained through embedded browser monitoring software (Col 6, Lines 54-58; Col 10, Lines 65-67 – Col 11, Lines 1-10). Subsequently, one of ordinary skill in the art would recognize that the collaborative filtering method utilized by the Robinson reference is not limited to using just Internet tracking information and demographic information to construct user profiles. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to enhance the “community” or profile generation method

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outlined in the Robinson reference with the usage tracking of the Belmont reference for the purposes of developing a more robust data set from which to develop a closer profile match.

Claim 9 is met by the aforementioned combination of the Perlman et al., Belmont, and Robinson references. These references disclose a method whereby a “server” uses “compiled” user information to “select” and “insert” targeted advertisements into user “requested” documents. These documents are subsequently “transmitted” to and “displayed” on the user terminal. In addition to the aforementioned, the Robinson reference discloses that “profile” may be “transmitted” from the client system to the server (Col 8, Lines 4-20).

Claims 20 and 26 are met by the aforementioned combination. The Perlman et al. WebTV® client terminal [100/108] embodiment contains “computer readable” memory [103/104] in which executable code may be stored.

In reference to claims 2-4, the technique of “inserting data representing the selected advertisement” is well known in the art (see Brown et al. (US Pat No. 5,887,133) – Figures 2 and 3). The Robinson reference teaches that the viewer profile information may be stored either locally or remotely on a central database server and that decisions as to which ads are to be displayed are determined where the profile resides (Col 7, Lines 24-34). It is well understood by those of ordinary skill in the art that a typical “ISP” architecture includes servers (Perlman et al.: Figure 1B illustrates a basic networked computing architecture wherein the “servers” [160/180] could be an ISP terminal server). As such, the teachings of the Robinson reference wherein the advertisements are inserted on servers may also meet the claimed “ISP” limitation. The Perlman et al. reference further suggests that the “ISP” may suppress the insertion of advertisements (Page 13, Lines 28-30)

In reference to claims 5-6 and 24, the Perlman et al. reference teaches that information such as advertisements may be “pre-downloaded” and stored in memory on the client system (Page 12, Lines 15-26; Page 18, Lines 11-20; Figure 5).

Claim 7 is met as aforementioned wherein the “information document” is a web page in HTML format (Perlman et al.: Page 7, Lines 29-31 – Page 8, Lines 1-7).

Claims 8 and 12 are met as aforementioned. The “profile” may be constructed “to further characterize the user” using a combination of user supplied demographic data, and tracking information (Robinson: Col 6, Lines 54-58; Col 10, Lines 65-67 – Col 11, Lines 1-10).

Claim 10 is rejected wherein the aforementioned Belmont reference discloses the use of an “electronic program guide” in conjunction with the generation of profile information (Col 3, Lines 53-65)

Claims 21-23 and 25 are met by the aforementioned combination wherein the “profile” may be “transmitted” from the client system to the server or retained locally (Robinson: Col 8, Lines 4-20). The viewer profile information would subsequently be used to determine which ads are to be “inserted” and “displayed” (Col 7, Lines 24-34) as is well understood in the art.

Claims 28-31 are met in view of the aforementioned combination. The Perlman et al. reference illustrates a “home entertainment system” comprising an Internet browsing device [100/108] embodied by a WebTV® client terminal, and a television [105] capable of “receiving” and “displaying” a television broadcast signal or an “information document” via a telephone or an ISDN connection (Page 7, Lines 8-17; Page 8, Lines 4-7). As aforementioned, the combined references further comprise the means “for monitoring the



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television programming” comprising “an electronic programming database monitoring unit,” disclosed in the Belmont reference.

7. Claims 9, 11, 20, 27-28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. (WO 98/56128), in view of Brodsky (US Pat No. 5,809,471).

In consideration of claims 9 and 11, as aforementioned, the Perlman et al. reference discloses an “informational retrieval system” whereby a “server” uses “compiled user profile” information that has been “transmitted” via the client to “select” and “insert” targeted advertisements into user “requested” documents (Page 12, Lines 5-21; Page 13, Lines 22-28). These documents are subsequently “transmitted” to and “displayed” on the user terminal. The reference suggests that advertisements are inserted into the retrieved “information documents” based on based on the “profile” which may be developed using a number of techniques including the tracking of viewership information that is subsequently sent to the server (Page 12, Lines 13-18). The reference, however, does not explicitly disclose the use of tracking “information associated with the television programming viewed by the user” unless one broadly interprets the tracking of viewed/browsed web sites on the WebTV® television set as a form of “television programming”.

The Brodsky reference discloses a method for extracting “keywords” from closed-captioning information of the most recently received program information. This information is subsequently used to compile a “dictionary” of terms that are used to retrieve supplemental information pertaining to the programming currently being watched (Col 3, Lines 51-67 – Col 4, Lines 1-3). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the extracted keyword teachings of the Brodsky in

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conjunction with the profile generation and viewer tracking teachings of the Perlman et al. reference for the purposes of utilizing the aforementioned extracted keywords of a viewed program to improve the aforementioned “profiles” in order to provide items of interest to viewers (Brodsky: Col 1, Lines 14-22).

Claims 20 and 27 are rejected in light of the rejection of claim 9 wherein the Perlman et al. WebTV® client terminal [100/108] embodiment contains “computer readable” memory [103/104] in which executable code may be stored.

Claims 28 and 32 are met in view of the aforementioned combined Perlman et al. and Brodsky references wherein the Perlman et al. reference illustrates a “home entertainment system” comprising an Internet browsing device [100/108] embodied by a WebTV® client terminal, and a television [105] capable of “receiving” and “displaying” a television broadcast signal or an “information document” via a telephone or an ISDN connection (Page 7, Lines 8-17; Page 8, Lines 4-7). The Brodsky reference teaches the “means for monitoring the television programming” using “closed captioning” information.

8. Claims 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. (WO 98/56128), in view of Bedard (US Pat No. 5,801,747).

In reference to claim 13, the Perlman et al. (WO 98/56128) reference shows the schematic structure of a communications network for use with an “information retrieval system” such as the WebTV® client terminal [180] (Figure 1B). The client terminal [180] facilitates shared screen viewing of television/internet content. Subsequently, it handles both the “request” for and “display” of “information documents” or HTML web pages (Page 5, Lines 9-19). While the reference teaches that information may be “pushed” to it based on

user/viewer profiles (Figure 5), it is silent as to the method for selecting “pushed” information based on the monitoring of television programming (Page 12, Lines 16-18).

The Bedard reference discloses a method and apparatus for monitoring television viewing. The reference teaches that this information may be used in conjunction with an electronic programming guide (EPG) to determine a “viewer profile” of preferred viewing categories (Col 2, Lines 5-45; Col 2, Lines 66-67 – Col 3, Lines 1-3). The reference further teaches that this profile may be used to “pull” targeted information from the Internet that may be of interest to the viewer and to subsequently “push” it to the user in accordance with the television model of interaction (Col 8, Lines 16-21, 51-63). It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the monitoring, profiling, and push/pull information retrieval teachings of Bedard in combination with the Perlman et al. “information retrieval system” in order to provide a method with which to effectively deliver web based information of interest to the user based on television viewership (Bedard: Col 1, Line 67 – Col 2, Lines 1-2, 13-22).

In reference to claims 14-15, the Perlman et al. reference discloses that the host server may provide supplemental information including “news” [308] and “reference information related to the content of the television programming” such as sports information provided on the ESPN® (Page 11, Lines 24-31 – Page 12, Lines 1-2).

Claim 16 is met wherein the “step of selecting the plurality of information categories” is based on the user input, since the user’s input is used to select which channels to watch. Infrequently watched program “categories” are dynamically removed from the preferred list (Bedard: Col 5, Lines 16-33). Additional methods wherein the viewer selects chooses from

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a plurality of categories are well known in the art (Young et al. (US Pat No. 5,353,121) Col 16, Lines 33-42; Col 14, Lines 47-67 – Col 15, Lines 1-22).

In reference to claims 17-18, the Bedard reference meets the claimed language wherein the selection of information categories is “at least in part on a profile of the user.” The reference teaches that information categories or “themes” are selected based on the viewer profile and the EPG (Col 4, Lines 24-65). The nature of the profile in the Bedard reference “includes information associated with the television programming viewed by the user” in the form of the channel title (ex. ESPN) as shown in Figure 2. Those of ordinary skill in the art would recognize that additional information “subcategories” could be included in the profile to further target programming information.

Claim 19 is met wherein the Perlman et al. reference discloses that information may be “pushed” to the client during off-peak periods (Figure 5; Page 12, Lines 18-21; Page 20, Lines 14-30). It is well known in the art that “push” technology does not require “direct user assistance”.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The White et al. (EP 0811940) reference discloses a representative embodiment of a WebTV® client.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907.

The examiner can normally be reached on Monday-Friday from 8:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

SEB  
December 16, 2002

  
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